

No. 21,068

United States Court of Appeals
For the Ninth Circuit

ILLINOIS TOOL WORKS, INC.,

Appellant,

vs.

REX L. BRUNSING, et al.,

Appellees.

APPELLANT'S REPLY BRIEF

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Appellees controvert appellant's statement of the case on the basis of seven enumerated "particulars" (Appellees' Br. pp. 1 and 2). None of those "particulars" raises any real dispute of fact. Appellant contends that—

(1) it is a matter of semantics rather than substance whether the patented carriers of Holmberg and Poupitch "grip" the containers carried by them (Appellees' Br. pp. 1, 2, 10, 13, 17 19, 20). Unquestionably, both the patented carriers (as well as the accused devices) "engage" the bead edge of the containers which they support.

(2) appellees' point that Holmberg contemplates "various handles . . . but not other means for manually grasping the *body* to carry the containers" is also a difference without substance (Appellees' Br. pp. 2, 11). Significantly, claim 13 of the Holmberg patent broadly teaches "means

adapted for manual grasping for carrying the body", as the District Court noted in its Memorandum of Decision (C.T. 282, para. 5).

(3) the third "particular" of difference, that containers enclosed within a Poupitch structure may be freely removed without the necessity of spreading any portion of the clip apart (Appellees' Br. pp. 2, 10, 18, 19, 25-26), overlooks the specific teaching of Poupitch (PX 3, Col. 3, ll. 50-56) which provides:

"... After the clip and the cans have been fully assembled, the cans are positively retained in interlocked association with the clip and cannot be removed until either the flanges 52 and 54 or the elements 56 and 58 have been manually shifted outwardly in order to open the restricted throats 68 and 70 sufficiently to permit the rims to pass there-through. . . ."

In addition, claim 1 of Poupitch further provides:

"... the cans cannot be thereafter removed from the clip until said margins have again been relatively shifted and spread apart."

The "particulars" specified in enumerated paragraphs (4), (5), (6) and (7) are of no greater importance than the others. Appellees' contentions that the accused device is not "like" the Holmberg or Poupitch structures; that the "tongues" of the accused device do not "depend" from the body of the clip; that the margins between the tongue and the rib of the accused device define a vertical space rather than a horizontal slot; and that, although the accused devices hold a pair of cans so they abut each other at the bottom edges, they do not counterbalance

each other raise no issues of fact. The precise construction of appellees' device is shown as an insert opposite page 12 of their brief, and that construction is the same as appellant's illustrations of the accused device, shown on pages 6, 12, 16, 17 and 27 of Appellant's Opening Brief. There is no dispute as to the manner in which appellees' device operates and the patents speak for themselves.

Appellees suggest, p. 3, that the accused device avoids infringement by providing a "gripping" action whereas devices of the patented structures merely support and carry the cans. Appellant's reply to this point appears on pages 17, 18, 19 and 27 of Appellant's Opening Brief.

Although appellees repeatedly assert that the accused structure is an embodiment of a wholly different idea and concept, they ignore the physical structure which *speaks* for itself. It shows that it has slots for receiving the rims of containers; that the body portions along the bottom edges of the slots are positioned to supportingly engage the under surface of the rims of the containers; that body portions along the top edges of the slots engage the inner surfaces of the container rims and maintain the under surfaces of said rims in engagement with the body portions along the lower edges of the slots; that portions of the carrier below the slots are curved to conform to the contour of the side walls of the containers; that portions of the carrier above the slots are also curved to conform to the contour of the container surfaces of the rims; that the slots are oppositely disposed so that an even number of containers will balance the carrier; and that a pair of cans mounted in an inter-dependent set of

slots or can-holding devices contact each other adjacent the bottom edges. No amount of rhetoric can change that.

Appellees state no sound reason why the additional use of a resilient member to hold the chimes or rims of containers should avoid infringement. An operational difference stemming from the use of a resilient tongue is at best no more than an improvement of the Holmberg patent. Accused devices do not escape infringement by merely adding features if they otherwise adopt the basic features of the patent [*Neff Instrument Corporation v. Cohu Electronics, Inc.* (9 Cir. 1961), 298 F.2d 82].

Appellees' suggestion that the legal question of infringement can or should be settled as a factual matter is not supported by *Graver Mfg. Co. v. Linde Co.* (1950), 339 U.S. 605, quoted at length on pages 4-6 in appellees' brief. In that case there was a factual issue as to "whether the substitution of the manganese which is not an alkaline earth metal for the magnesium which is, . . . is a change of such substance as to make the doctrine of equivalents inapplicable." Appellees' attack on the reliability of testimony given by plaintiff's witness Poupitch, pages 7 and 8 of appellees' brief, is unwarranted in fact and in law. In fact, the testimonies of Mr. Poupitch and Mr. Wood are not in conflict. In law, the personal attack is beside the point on this appeal. Here, appellees do not discuss any factual dispute in this case which, if resolved in their favor, would avoid infringement. Here, the disputed issues are based on principles of claim construction and are legal rather than factual [*Sanitary Refrig'r Co. v. Winters* (1929), 280 U.S. 30, 36. Cf. *U.S. Chemicals Co. v. Carbide Corp.* (1942), 315 U.S. 668, 678].

Appellees argue, pages 8-10, that the accused structures avoid infringement since they do not include a body having a U-shaped cross-section. That issue, appellees contend, "could have been resolved by the District Court without any oral testimony whatsoever merely by viewing the drawings and exhibits and drawing its own conclusion." Appellant agrees. It is not a matter which requires expert testimony. Appellant readily admits that the U-shaped cross-section of the accused clip is not identical to the inverted U-shape shown in the Holmberg patent, but it is appellant's position that such a slight difference is immaterial. Functionally, the shapes are equivalent, as pointed out in Appellant's Opening Brief, pages 11-14.

Even assuming for sake of argument that a cross-section of the accused clip (shown in Fig. 6 opposite to page 12 in appellees' brief) is not U-shaped, still there is literal infringement of claims 4, 11, 12 and 13, none of which recites a carrier body having a U-shaped cross-section. The law on this point was clearly recognized in *Hansen v. Colliver* (9 Cir. 1960), 282 F.2d 66, where this court specifically referred "to the well established rule of construction that a broad claim will not be construed to contain limitations expressed in the more narrow claims. (citations omitted)."

Appellees argue, page 10, that the patents in suit should be limited to the form of the invention shown since the form of the invention is "*necessary to the functions which the patent ascribes to the invention*", citing Walker on Patents. Specific reference is made to the use of "slots" in Holmberg and "throats" in Poupitch to support the containers. The argument is not germane. Here, the ac-

cused device also has slots which function in precisely the same manner. The fact that Holmberg's specification describes one manner by which slots may be formed in the body of a carrier is no basis for limiting both that patent and the Poupitch patent. It is the function of the slots which is important, not the manner in which they are formed.

Appellees' argument, page 11, that a freely pivotal handle member is essential to the invention of Holmberg is covered on pages 19 to 21 of Appellant's Opening Brief. Appellees' further attempt to limit even the Poupitch invention to structures using only freely pivotal handle members is equally unsound. This, because Poupitch does not even have a pivoted bail-like handle, but it illustrates and describes a carrier having a handle 26 with finger openings 40 and 42. Such "handle means" is essentially the same as the carrier body and finger openings of the accused device. In Holmberg, Poupitch and Brunsing alike, the carriers are held from the top and the containers remain in an essentially vertical position. Fingers inserted through a bail or openings in a carrier body like that of Poupitch (or of the accused device) pivotally support the package in the same manner. Indeed, appellees' expert, Mr. Wood, testified that a "handle" could be something that is grasped by the fingers as well as the hand (R.T. 551-552), and appellees' own literature shows that the accused devices are intended to be carried vertically rather than at some other and unnatural angle (PX 31 and 32).

Appellees' legal argument, pages 13-16, under the heading "The Omission Of An Element From A Combination

Patent Avoids Infringement” considers the doctrine of equivalents. But, appellees fail to show how, why, or in what manner *Simons v. Davidson Brick Co.* (9 Cir. 1939), 106 F.2d 518, or any other cited authority, applies to the structures in this case. Appellees do not state what element or elements of the claims (or their equivalents) cannot be found in the accused structure. Appellant submits the matter on the argument of Appellant’s Opening Brief, pages 11 through 21 and 23 through 29.

Under the heading **“The Addition Of ‘Snap Action’ Adds No Substance To Appellant’s Case”**, pages 16-20, appellees direct their argument to non-infringement of the Poupitch patent. Appellees contend that a Poupitch carrier retains cans or containers as in Holmberg and allows the cans “to pass freely in and out of his structure when the cans are at an intermediate angle to the carrier”, citing R.T. 365, ll. 5-11.

At the cited reference, Mr. Poupitch testified under cross-examination with regard to one specific exemplar of the Poupitch clip and with respect to that particular clip he testified:

“Q. What I am trying to get at is this, Mr. Poupitch: That can comes out of your clip freely, does it not?

“A. It came out reasonably freely, yes.

“Q. And it goes in the same way?

“A. Yes.”

There was no evidence linking this testimony to other embodiments of the Poupitch invention. The face of that patent shows that it is not directed to a concept which allows the can “to pass freely in and out of the structure

when . . . at an intermediate angle." Appellee's unwarranted inferences to the contrary are conclusively contradicted by the patent specification, quoted on page 2 of this brief.

Appellees also argue, page 17, that the accused devices differ from the patented structures of Holmberg and Poupitch by reason of a third can-holding element. They assert that the third element maintains a gripping action "and it becomes essential when the device is turned to the angle where the cans will drop out of Holmberg and Poupitch". Since appellees must admit that the accused device uses the two can-holding elements of the patented structures, their attempt to avoid infringement on the basis of an improved result occasioned by adding a third can-holding element should be rejected. [*Neff Instrument Corporation v. Cohu Electronics, Inc.* (9 Cir. 1961), 298 F.2d 82, 89-90].

Appellees urge, page 20, that the doctrine of equivalents should not be applied when the means and operation of the accused device are basically different. The case of *Boyden Power Brake Co. v. Westinghouse* (1898), 170 U.S. 537, 18 S.Ct. 707, is simply not in point. In that case there was a complete departure from the patented structure. Appellees' accused devices infringe not simply because they derive the same results as the patented devices, but because the results are obtained by essentially the same can-holding engagements as the patented devices.

Appellant submits that the undisputed facts of this case compel the application of the doctrine of equivalents for the same reasons given in *Hansen v. Colliver* (9 Cir. 1960), 282 F.2d 66. In that case, and even though the District

Court found that the table top of the accused device was not a "guide" as called for by the patent claims, this Court held, page 69:

"... While we are inclined to disagree with the view of the district court that the table top of the appellees' device is not a guide and therefore does not literally infringe appellant's patent, we are wholly satisfied that the undisputed facts compel the application to this case of the doctrine of equivalents. The doctrine is applicable if the accused device performs substantially the same function in substantially the same way to obtain the same result as that claimed for the patented device. (citations omitted)."

"Normally, the question of infringement is one of fact. In this case, however, since the facts are not in dispute the question of infringement resolves itself into one of law, depending on a comparison between the patent claim in issue and the accused device, and the correct application thereto of the law of equivalency. (citations omitted)."

Appellees' argument, pages 21 through 26, relating to the doctrine of the file wrapper estoppel and its application to the **Holmberg** and **Poupitch** patents, is submitted generally on pages 21-23 and 29-30 of Appellant's Opening Brief. The text book views which appellees cite from *Corpus Juris Secundum* have no application to the prosecution history of either patent in suit and should, in any event, take a back seat to the views of this Court as expressed in *No-Joint Concrete Pipe Co. v. Hanson* (9 Cir. 1965), 344 F.2d 13, cert. den. (1965), 382 U.S. 843.

Some eight claims were cancelled in **Holmberg** during the patent prosecution. None of those claims was can-

celled by reason that the invention was limited to the action of gravity; or that a patented device allowed a free entrance and exit of a container at an intermediate angle; or that the patented device provided a free downward swinging action for seating the containers; or that such devices provided a free upward swinging action to accomplish removal. Moreover, none of the patent claims was amended during the patent prosecution for purposes of obtaining an allowance on the basis of such functions.

With regard to the Poupitch patent and the law of file wrapper estoppel, pp. 22-26, appellees attempt to distinguish *Payne Furnace & Supply Co. v. Williams-Wallace Co.* (9 Cir. 1941), 117 F.2d 823 on the mere basis that that case involves a situation of validity rather than infringement. Even so, the principle is the same, for the problem under review is one of claim construction.

Appellee's argument, page 24, that abandoned claim 14 of Poupitch contained the same elements as allowed claims 1 and 2 ignores the fact that claim 14 called for "a plurality of clips as defined in claim 8, connected to said handle member in spaced relationship". It was by reason of this *further* recitation that the District Court applied what it stated to be the doctrine of file wrapper estoppel (C.T. 280, Finding of Fact XIX). The District Court recognized that claim 14 differed from claims 1 and 2. It applied the wrong legal principle when it held that the doctrine of file wrapper estoppel limited the invention to a single clip without a handle. This holding was in conflict with the authorities cited in Appellant's Opening Brief, page 30. Appellees cite no contrary authority and appellant is aware of none. As a matter of fact, the patent

includes in Fig. 8 the very handle which the District Court wrote out of the claims.

Appellees' argument, pages 24-25, has no bearing either on the application of the doctrine of file wrapper estoppel or on any real issue presented by this appeal. In fact, it is impertinent to impugn Mr. Poupitch's ability to draw a clip coming under the teaching of his patent and which "would hold more than two cans". He was merely following instructions. Appellees' counsel initiated the making of the drawing during cross-examination, and particularly instructed Mr. Poupitch as to what features he should and should not draw (R.T. 216-221). The demonstration was concluded with counsel's statement:

"Q. It's not necessary to draw in the tongues. I think everybody understands how it works." (R.T. 221).

Appellees' remarks, page 25, concerning the patent prosecution of the Poupitch patent specifically refer to the fact that the Examiner "first objected to claim 1" and the fact that "the Trexler Firm elected '. . . to prosecute claims drawn to the specifications shown in figures 1-3' ". Those remarks are both misleading and inaccurate.

The Examiner's "objection" as to the inferential inclusion of a plurality of cans was traversed in the following amendment and claim 1 then issued *without limitation*, fully contemplating a can package including "a plurality of cylindrical cans or the like having annular end rims disposed in side-by-side substantially abutting and parallel relationship" (PX 3, col. 4, ll. 64-66). Applicant traversed the "objection" on the basis that a reference to a

plurality of cans "greatly facilitates the definition of the novel structure so that the claims are more definite and more easily understood" (DX U, page 30). Thus, in allowing the claim, the Examiner approved the claim because it covered a plurality of cans.

Fig. 8 of the Poupitch patent shows the Poupitch structure supporting six cans in the same manner as the accused clip of appellees. Both are used as a "six pack."

Applicant's election of species, page 25, had nothing at all to do with limiting the invention to "only one clip which supports only two cans" as suggested by appellees. The election was based on the Examiner's requirement for an election as to "the species of Figures 1, 4, 6 and 9" (DX U, page 26). No election was required as to the illustration of Fig. 8, which shows a plurality of clips, since that figure is general and relates to all "species"; it is not itself a "species" of the invention. Fig. 8 merely illustrates how a plurality of clips might be used to form a package irrespective of whether the clip was constructed according to the "species" shown in Figs. 1, 4, 6 or 9.

Appellees' point, page 25, that claim 4 of the Poupitch application was withdrawn from examination by the Examiner is also misleading. The claim was eventually allowed as claim 4 of the Poupitch patent. No charge of infringement has been made as to claim 4 but there is no legal basis for holding that failure to charge a device as an infringement of one claim (such as claim 4) avoids infringement of other patent claims (such as claims 1 and 2 of Poupitch). Patent claims are to be read separately [*Graver Mfg. Co. v. Linde Co.* (1949), 336 U.S. 271, 69 S. Ct. 535, 538].

Much to appellant's embarrassment, appellees' brief correctly points out, page 26, that appellees' patent expert, Mr. Wood, gave more testimony on the prior art than recognized in **Appellant's Opening Brief**. Appellant apologizes to the Court and to counsel for any inconvenience counsel's oversight may have occasioned. The point, however, remains unchanged. The additional testimony, previously overlooked by appellant's counsel in reviewing the Reporter's Transcript, consisted of statements identifying the issue dates of six prior art patents, followed by a brief description of what each patent teaches.

All six of the foregoing patents are included in the book of prior art mentioned in Appellant's Opening Brief. It is significant that appellees do not relate any of these six essentially non-analogous patents to any claims of the patents in suit, either by way of expert testimony or argument, and do not present any cogent reason why the claims should be limited on the basis of such teachings.

Appellees state, page 27, that "it was up to the Court to determine from the testimony and from the patents what was in fact the state of the prior art". Appellant agrees. It is significant that the Court did not limit the claims of either patent in suit by reason of the prior art. Indeed, the District Court found that "plaintiff's combination patents in suit were improvements" (C.T. 277). The Court's legal conclusion that the accused device does not infringe either patent in suit was made on specific enumerated "differences", each particularly set forth in Findings of Fact XXI and XXII (C.T. 281-284). None of those differences was justified on the basis of prior art. The Court's Memorandum shows that the "differences"

were primarily based upon an improper use of file wrapper estoppel. In addition, the Court erred by considering all claims together, rather than as separate specifications of invention, and by limiting the claims to the specific forms of carriers illustrated in the patents in suit.

Appellees argue, pp. 27-29, that the claims of the patent should be limited since appellant has not commercialized the patented structures. Appellant's argument on this point is set forth on pages 32 through 34 of Appellant's Opening Brief.

In support of its argument appellees rely on the testimony of Mr. Poupitch as showing that appellant made "very few" of the patented devices. The particular testimony at R.T. 127-129, relied upon by appellees, merely shows that the witness did not "know of any machine" for making a specific exemplar of Holmberg, namely Defendants' Exhibit D. That testimony is hardly support for the proposition that the Holmberg patent was not commercialized by plaintiff. The clerk's transcript shows that Illinois Tool Works, Inc. manufactured approximately 1,000,000 of the patented Holmberg container carriers (C.T. 185). Although such carriers were not of the specific form shown in the drawings, their manufacture is at least more than a modest commercial use of the invention. Mr. Holmberg's testimony (R.T. 139-140) does not contradict this fact; it simply indicates that at one point in time Mr. Poupitch had been told that appellant decided not to commercialize them "for the time being" (R.T. 140).

Appellees further argue, page 28, that the District Court was "justified in applying a narrow rather than a broad range of the doctrine of equivalents" on the au-

thority of *General Motors Corporation v. Kesling* (8 Cir. 1947), 164 F. 2d 824. Appellant respectfully submits that the *General Motors* case is no authority for the proposition that claims of a patent may be restricted upon the argument that a patentee has not commercialized his invention. As a matter of fact, in that case the Kesling invention was held not to be a "paper patent" and the patent was *not* narrowly construed (164 F. 2d 828). The Court found that even though there was a difference in the method by which the accused device operated compared with the device described in the patent, and even though the "accused may be the better structure", still the patent was infringed.

For the sake of argument, we may assume that appellant's manufacture of 1,000,000 devices may not be an impressive commercial use of the Holmberg invention. But this alone should not deprive the owner of a patent of those rights given to him by law. Nothing in the Patent Statute would justify or warrant an arbitrary limitation of a patent simply on the basis that there was no impressive commercial use. This is established by the *Paper Bag Patent Case* (1908), 210 U.S. 405, cited in Appellant's Opening Brief. That case is the leading case for the proposition that failure of the patentee to make use of a patented invention does not affect the validity or scope of a patent. *Special Equipment Co. v. Coe* (1945), 324 U.S. 370, 379; *Hartford-Empire Co. v. U.S.* (1945), 323 U.S. 386, 417; *McCullough v. Kammerer Corporation* (9 Cir. 1948), 166 F. 2d 759, 767, cert. den. 335 U.S. 813; *Preformed Line Products Co. v. Fanner Mfg. Co.* (6 Cir. 1964), 328 F. 2d 265, 279, cert. den. 379 U.S. 846; *Rail-Trailer Co. v. ACF Industries, Inc.* (7 Cir. 1966), 358 F.

2d 15, 16; and *Application of Tenney* (CCPA 1958), 254 F. 2d 619, 623.

In *Special Equipment Co. v. Coe* (1945), 324 U.S. 370, the Supreme Court reversed *Special Equipment Co. v. Coe* (D. of C. Cir. 1944), 144 F. 2d 497. There, the Court of Appeals denied a claim to a subcombination invention for the reason “. . . that appellant’s purpose in making a distinct patent claim on the subcombination is not to stimulate the commercial development or financial return from that patent. . . .” (144 F. 2d 498). The Court, page 499, rejected the *Paper Bag Patent Case* “because we believe that its principle, which is inconsistent with the constitutional provision that the patent law ‘promote science and the useful arts,’ has been overruled by subsequent decisions. . . .” A lengthy quote taken from the Supreme Court decision which answered that reasoning and overruled the Court of Appeals on that very issue is set forth in Appendix A of this brief.

This Court has followed the *Paper Bag Patent Case* in the past and there is no reason for it to depart from its authority now. In *McCullough v. Kammerer Corporation*, 166 F. 2d 759, 766, this Court said:

“The law does not *compel* a patent owner to *sell* his patent. Aside from entering into *contracts not to use an invention*, which are a restraint of trade, the patent owner may refrain from doing anything at all with his patent—its validity is not affected by his non-use. *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 28 S.Ct. 748, 52 L.Ed. 1122.”

Appellees make no attempt to distinguish the *Paper Bag Patent Case* from the facts of this case, nor do they

cite any contrary authority which might support their position. Appellees argue that *Smith v. Mid-Continent Inv. Co.* (8 Cir. 1939), 106 F. 2d 622, cited in Appellant's Opening Brief, does not support the principle that "paper patents" are entitled to protection. Appellant's Opening Brief, pp. 32-35, cites *Smith* only for the proposition that a patent does not become a "paper patent" merely because the owner does not use the constructions shown in the drawings and described in the specification.

In three brief sentences, page 29, appellees submit their case that the accused device lacks essential elements of the patented devices. They rest their case in part upon a reference to Mr. Wood's testimony under direct examination; an inference that the Court was "Obviously . . . impressed with Mr. Wood's testimony, the demonstrations, and the various objects of real evidence introduced by defendant"; and the conclusion that the testimony supports Findings of Fact XII, XXI and XXII.

With regard to the construction and operation of the accused device, in comparison with the patented structures, Mr. Wood made it abundantly clear that the accused device did in fact include the essential elements of the claims. The particulars in which he did so are collected in a schedule included in Appendix B to this brief.

Appellant submits that the substance of testimony given by appellees' own expert shows that the accused device embodies the inventions as claimed in both of the patents in suit. The accused devices, like Holmberg, are of the type where a plurality of cans "are held by the upper rim and the downward swinging action brings about an abutment at the bottom edge of the can . . ." (DX V, p. 32);

and they, like Poupitch, are “adapted to be resiliently snapped onto a plurality of rims of adjacent containers in a manner which provides a positive interlock between the clip and the containers so as to prevent subsequent removal of the containers until portions of the clip have been spread apart.” (PX 3, col. 1, ll. 35-40).

In conclusion, appellant submits that the judgment below should be reversed on the issue of infringement and the cause should be remanded to the District Court for trial of the issue of validity.

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CERTIFICATE OF COUNSEL

I certify that, in connection with the preparation of this brief, I have examined Rules 18, 19 and 39 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

CARL HOPPE,
Attorney for Appellant.

(Appendices A and B Follow)

Appendices A and B

Appendix A

Excerpt from *Special Equipment Co. v. Coe* (1945), 324 U.S. 370, at pages 377-379:

“In answering it the court below assumed that such purpose to protect the whole invention was to be achieved by complete suppression of the use of the subcombination invention and that the suppression for the protection of the complete machine would invalidate the patent because it would be contrary to the constitutional purpose and to the spirit if not the letter of the patent laws. We think both assumptions are unwarranted. Section 4886 of the Revised Statutes (now Section 101 of U.S. Code, Title 35) authorizes ‘any person who has invented . . . any new and useful . . . machine’ to ‘obtain a patent.’ The patent grant is not of a right to the patentee to use the invention, for that he already possesses. It is a grant of the right to exclude others from using it. As the statute, R.S. § 4884, provides, the grant is of the ‘exclusive right to make, use, and vend’ the invention, and this includes the exclusive right to license others to make, use and vend it. By the very terms of the statute the grant is nothing more than a means of preventing others, except under license from the patentee, from appropriating his invention.

“It by no means follows that such a grant is an inconsistent or inappropriate exercise of the constitutional authority of Congress ‘to promote the Progress of Science and useful Arts’ by securing to inventors ‘the exclusive Right to their . . . Discoveries.’ Congress, in the choice of means of promoting the useful arts by patent grants, could have provided that the grant should be conditioned upon the use of

the patented invention, as in fact it did provide by the Act of 1832 (4 Stat. 577) authorizing the issue of patents to aliens conditioned upon the use of the invention, which provision was later repealed (5 Stat. 117, 125). But Congress was aware that an unpatented invention could be suppressed and the public thus deprived of all knowledge or benefit of it. It could have concluded that the useful arts would be best promoted by compliance with the conditions of the statutes which it did enact, which require that patents be granted only for a limited term upon an application fully disclosing the invention and the manner of making and using it. It thus gave to the inventor limited opportunity to gather material rewards for his invention and secured to the public the benefits of full knowledge of the invention and the right to use it upon the expiration of the patent.

“This Court has consistently held that failure of the patentee to make use of a patented invention does not affect the validity of the patent. *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405; *Crown Die & Tool Co. v. Nye Tool Works*, 261 U.S. 24, 34; *Woodbridge v. United States*, 263 U.S. 50, 55; *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127; *Hartford-Empire Co. v. United States*, 323 U.S. 386, 433. . . .

“Congress has frequently been asked to change the policy of the statutes as interpreted by this Court by imposing a forfeiture or providing for compulsory licensing if the patent is not used within a specified time, but has not done so.” (footnotes omitted).

Appendix B

Schedule of Mr. Wood's Testimony Referred to in the Brief, page 17, to the Effect That:

1. The term "slot" is a fair definition of the space between the tongue and rib of the accused device (R.T. 547, ll. 23-25);

2. The slots are formed in the body of the accused device and there are two of them at the cross-section (R.T. 548, ll. 1-5);

3. The slots formed in the accused device are on opposite sides of the body (R.T. 537, ll. 5-9);

4. The accused device provides vertical support of the cans from one lip of the slot or one margin of the slot (R.T. 548, ll. 21-23);

5. The lower margin of the slots supports the bead of the can (R.T. 541, ll. 4-9);

6. The slots of the accused device are disposed in pairs on equal distances from the central plane (R.T. 582, ll. 20-24);

7. "... the same result is reached (in Brunsing as in Holmberg) in the general sense that you have vertically disposed containers attached to a carrier . . ." (R.T. 472, ll. 10-11);

8. "... in Brunsing you have the 'inside and outside can engaging means sufficiently close together to prevent the disengagement,' " (R.T. 472, ll. 4-6);

9. "... in Brunsing the cans, when they are carried, abut each other." (R.T. 466, ll. 20-21);

10. In the Brunsing clip, the action of gravity increases the pressure engagement between the cans at the bottom (R.T. 568, ll. 13-18);

11. Cans may be assembled in the Brunsing clip "at an angle to the axis of the can" (R.T. 455, ll. 12-20);

12. Lifting a package of cans in the Brunsing clip, through the action of gravity, causes the cans to move together (R.T. 572, l. 20-R.T. 573, l. 1);

13. In the Brunsing clip, the effect of gravity acting on "each of two opposed can is the same" and in that sense the forces of gravity counterbalance one another (R.T. 587, l. 14-R.T. 588, l. 4);

14. The cans in the Brunsing clip must be tilted upwardly in opposition to the action of gravity for removal (R.T. 585, ll. 12-24).

15. The tongues of the Brunsing clip are resilient elements (R.T. 505, ll. 18-20).

16. When the tongues of the Brunsing clip are spread apart from the rib, they move to increase the space between the engaging end of the tongue and the central rib (R.T. 512, ll. 19-24).

17. The tongues of the Brunsing clip move a distance sufficient so that there is enough space to accommodate the thickness of a can rim or chime (R.T. 512, l. 25-R.T. 513, l. 4).